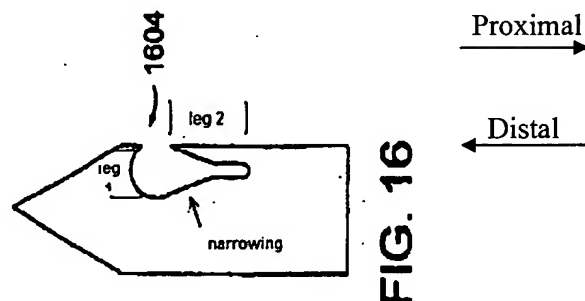


REMARKS

In the Non-Final Office Action dated March 29, 2006, claims 1-43 are pending in the application. Of these, claims 1-8 and 37-43 are withdrawn, and claims 9-36 are rejected. More particularly, claims 9-13, 18-21, 27-29, and 35 are rejected under 35 U.S.C. §103(a) over U.S. 5,152,749 to Giesy et al. (Giesy) in view of U.S. 6,723,107 to Skiba et al. (Skiba), and claims 14-17, 24-25, 29-34, and 36 are rejected under 35 U.S.C. §103(a) over Giesy in view of Skiba, and further as a matter of design choice. Applicants amend claim 9 to address matters of form. Applicants amend claim 27 to include the subject matter of claim 29.

The Action rejects claim 9 over Giesy in view of Skiba. Claim 9 recites a connector pair for attaching a medical implant to a delivery device, the connector pair comprising, a closed loop connector located at an end of a medical implant, and a slotted connector formed in a distal end of a shaft of a delivery device for interfitting with the closed loop connector of the medical implant, the slotted connector including first and second legs, the first leg extending radially into the shaft and the second leg extending axially in a distal direction along the shaft and including a narrowing for locking the looped connector into the second leg. The Action concedes that Giesy fails to describe a first leg extending radially into the shaft and a second leg extending axially in a distal direction along the shaft, and asserts that Skiba describes this subject matter at Figure 16.

Applicants disagree. The Action makes reference to Figure 16 of Skiba, set forth as follows¹:



¹ For reference, Applicants have inserted two arrows generally pointing in proximal and distal directions, respectively.

The element identified by the Examiner as the second leg (leg 2) extends in a proximal direction, not a distal direction. Therefore, neither Giesy nor Skiba describe a second leg extending axially in a distal direction along the shaft, as recited in claim 9. Since a *prima facie* case of obviousness requires that all claim limitations be taught or suggested (MPEP 2143), this obviousness rejection fails. Applicants request withdrawal of the 35 U.S.C. §103(a) rejection of this claim.

Independent claims 16, 18, and 21 also include the feature of a second leg (or slot) extending axially in a distal direction, and claims 10-17, 19-20, 24-25, 28-34, and 35-36 depend from these claims. Accordingly, Applicants request withdrawal of the §103(a) rejections of these claims.

Applicants amend independent claim 27 to include the limitations of dependent claim 29, which the Action rejects over Giesy in view of Skiba, and further as a matter of design choice. Amended claim 27 recites a connector pair having a closed loop connector, and a slotted connector extending into a shaft from a first location to a second location at least as distal along the shaft as the first location, with the slotted connector having a narrowing that includes a protuberance in a wall of the slotted connector. The Action references the various configurations in Skiba of Figures 11-17 “all with the same goal of securing the loop material in the slotted portion with a narrowing as in fig 16 or a protuberance as in fig 12.” The Action also asserts that “it appears that the slot structures of Skiba perform the function of securing the loop material equally well as that disclosed in the application.”

Applicants disagree. According to In re Rice (341 F.2d 309, 144 USPQ 476 (CCPA 1965)), a rejection on the basis of design choice is proper if the difference between the claimed invention and the art cited does not result in a difference in function or give unexpected results. Moreover, as explained in In re Chu, “finding of ‘obvious design choice’ [is] precluded where the claimed structure and the function it performs are different from the prior art,” (66 F.3d 292, 298-299, 36 USPQ2d 1089, 1094-1095 (Fed. Cir. 1995) citing In re Gal (980 F.2d 717, 25 USPQ2d 1076 (Fed. Cir. 1992)).

Amended claim 27 recites a device with different structure and function from those cited by the Examiner. With respect to Figures 11-12 of Skiba, the depicted devices cannot be used

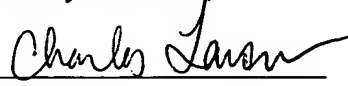
with a loop structure at all, since there is no entry slot or leg for the loop to enter. Moreover, the configurations of Skiba in Figures 13-17 include narrowed bottom portions so that suture can be "wedged into the narrowed bottom portion" (see column 3 fourth paragraph of Skiba). In contrast, a protuberance can be used to serve as a barrier for a filament's exit (paragraph [0204] of the instant application). More particularly, in one exemplary use, an operator forces a loop past the protuberance, which then locks the loop inside the slot (paragraph [0205] of the instant application). As far as Applicants can tell, none of the slotted configurations of Figures 11-17 in Skiba are suitable for the function of forcing a loop past a narrowing to lock the loop inside a slot. Thus, a protuberance (at least) offers a different type of locking mechanism than the narrowings of Skiba in Figures 13-17. Therefore, since the claimed structure has a different structure and function from what is disclosed in Skiba, the rejection as a matter of design choice is improper. Accordingly, Applicants request reconsideration and withdrawal of the rejection of the subject matter of amended independent claim 27. Claims 28 and 30-36 depend from these independent claims. Accordingly, Applicants request withdrawal of the rejections to these claims.

In view of the above amendments and remarks, Applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-1945, under Order No. MIY-P03-024 from which the undersigned is authorized to draw.

Dated: June 28, 2006

Respectfully submitted,

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